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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,018	09/20/2001	Joseph E. Kaminkow	0112300-581	2458
29159 7590 01/25/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER	MCCULLOCH JR, WILLIAM H
		ART UNIT	PAPER NUMBER	
		3714		
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	09/957,018	KAMINKOW, JOSEPH E.
	Examiner	Art Unit
	William H. McCulloch Jr.	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,6-12 and 14-25 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,6-12 and 14-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/2006 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) with mailroom date 10/23/2006 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the examiner has considered the information disclosure statement.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-7, 9-12, 14, 21-22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,102,798 to Bennett.

The examiner notes that the independent claims presented have substantial (but not total) overlap in scope. The examiner has perceived the differences in the scope of the independent claims. However, in the interest of conciseness, the examiner will address the most specific elements of the independent claims. All broader limitations are addressed because they are within the scope of the below-described elements and the teachings of Bennett. Regarding claims 1, 6, 9, 14, 21, and 25, Bennett teaches the following limitations:

- A gaming device (figs. 1,8), the gaming device comprising:
 - A display device (display 11);
 - An input device (touch screen, see at least 2:65-3:12)
 - A processor in communication with the display device and the input device (game control processor circuits, see at least 2:60-4:19 and fig. 6),
wherein the processor is programmed to:
 - Cause a plurality of masked selections to be displayed to a player by the display device (see at least fig. 2 and 2:65-3:12);
 - Associate a plurality of different values with the masked selections prior to said masked selections being picked by the player and without displaying which values are associated with which selections (note the claims only require the values to be different values and do not require that the plurality of values be the same values; see at least figs. 2-5 and 2:65-4:19);

- Enable the player to pick a plurality of said masked selections for a designated number of sets, said designated number being at least two (the examiner interprets a “set” as a plurality of selections chosen by the player; see at least figs. 2-5 and 3:4-8);
- Form the designated number of sets of a plurality of said values, each set determined by the player picking a plurality of said selections for said set wherein the plurality of values in each set are based on the values associated with the selections picked by the player for said set (see at least figs. 2-5 and 2:65-4:19);
- Cause a display of each of the sets and the values in each set (see at least figs. 2-5);
- Generate a plurality of awards by selecting a plurality of but not all of the values in each one of said sets (selections bearing a prize are selected (e.g. 2 credits), whereas “no prize” zones are not used to generate the award(s); see at least figs. 2-5 and 3:51-54);
- Generate a resulting award by performing at least one mathematical operation on the awards generated from the set (adding the prize bearing selections and/or multiplying them by a bet of credits; see at least figs. 2-5 and 3:55-62);
- Provide said resulting award to the player (see at least 3:55-62).

Claims 3-4, and 11-12 are explained above with regard to the independent claims. Regarding claim 7, Bennett teaches that the display device displays the

selections and reveals values associated with the selections that are not picked by the player (see at least 31-46). Regarding claims 2, 10, 22, and 24, Bennett teaches selecting at least the largest value or award of each set (see at least 3:55-62).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 15-20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of U.S. 6,345,824 to Selitzky.

Regarding claims, 8, 15-16, 18-19, and 23 Bennett teaches the invention substantially as described above. Bennett lacks in explicitly teaching selecting "at least one but not all of" the awards from the plurality of different sets in order to generate a resulting award. Selitzky teaches a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is rewarded (see at least 7:1-13). It would have been obvious to one of ordinary skill in the art at the time of invention to apply the teaching of Selitzky (only awarding the highest ranking bonus combination) to the invention of Bennett in order to allow more award bearing selections (in Bennett) to be displayed on the screen without the provision of large awards paid by the gaming establishment, resulting in more frequent but smaller value awards being paid out by the gaming machine. Such a result is favorable to a gaming establishment because it allows customers to be frequently

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awarded (which results in more repeat customers) without the need for the gaming establishment to pay large sums.

Bennett describes claims 17, 20, and 24, as shown with regard to claims 2, 10, 22, and 24 above. Bennett describes claim 19 with respect to claims 1, 6, 9, 14, 21, and 25 above.

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892 form.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
1/20/2006

wm



CORBETT B. COBURN
PRIMARY EXAMINER